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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/060,753	01/30/2002	Toshifumi Komatsu	2970.98US01	6971

7590 06/16/2004

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EXAMINER

GILLIAM, BARBARA LEE

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 06/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/060,753

Applicant(s)

KOMATSU ET AL.

Examiner

Barbara Gilliam

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5,6,9,12-17 and 19-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5,6,9,12-17 and 19-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendment filed March 8, 2004 has been entered and fully considered.
2. Claims 1-3, 5-6, 9, 12-17, 19-25 are present.
3. In light of the claim amendments, all previous rejections of record are withdrawn.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
 - a. Claim 12 is dependent upon canceled claim 10.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. Claims 1-3, 5-6, 9, 13-17, 19-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoogmartens et al. (US 5,922,506) in view of Asano et al. (US 6,106,992).

a. In US 5,922,506, Hoogmartens et al. teach a negative-working photosensitive imaging element comprising on a hydrophilic surface of a support in the order given, a hydrophobic photopolymerization layer contiguous to the hydrophilic surface of the support and comprising at least part of at least one unsaturated compound, a hydrophobic photosensitive layer contiguous to the polymerizable layer and comprising at least part of at least one hydrophobic thermoplastic polymer and at least one photoinitiator and optionally a receptor layer (claim 1). Examples of the thermoplastic polymers include polyvinyl chloride and copolymers (column 6, lines 50-51). Agents to improve the wetting an/or adjust the adhesion of the photopolymerizable composition may be added (column 7, lines 37-43 & column 8, lines 42-46). The support can comprise a polyethylene layer (column 10, lines 44-54) and comprise one or more hydrophilic layers such as layers of hardened polyvinyl alcohol (column 10, lines 25-36). The support meets the present limitations for the carrier layer and the hydrophilic layer coated thereon meets the present limitations for the membrane layer. The imaging element of Hoogmartens et al. may comprise a temporary protective layer on top of the photosensitive layer, which can comprise polyvinyl alcohol. The temporary layer can be removed before or after the photoexposure step (column 10, lines 62-67). Preferably the imaging element either comprises a receptor layer or a transfer layer and a receptor layer wherein the transfer layer is between the photosensitive composition and the receptor layer. Suitable receptor layers include transparent organic resins

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(column 11, lines 1-25). The temporary protective layer and the receptor layer meet the present limitations for the ink-receptive, radiation transmissive layer. Additionally the temporary protective layer meets the present limitations for the printable cover sheet. Hoogmartens et al. do not teach organic or inorganic particles in the temporary protective layer however, based on the teachings of Asano et al. (column 14, lines 55-67 & column 21, lines 33-46) it would have been obvious to incorporate fillers such as calcium carbonate into the temporary protective layer to reduce to cost.

Response to Arguments

8. Applicant's statement filed March 8, 2004 has been fully considered but they is not persuasive. The claims are obvious in view of Hoogmartens et al. (US 5,922,506) as modified by Asano et al. (US 6,106,992).

9. To avoid abandonment of the application, Applicant is reminded that amendments and arguments submitted in reply to a non-final Office action must be "fully responsive." MPEP 714.02(b): "In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to the Office action. The reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner's action and must reply to every ground of objection and rejection in the prior Office action. The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. If the reply is with respect to an application, a request may be made that objections or

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requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated. The applicant's or patent owner's reply must appear throughout to be a bona fide attempt to advance the application or the reexamination proceeding to final action. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section." See also MPEP 714.03-714.04.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara Gilliam whose telephone number is 571-272-1330. The examiner can normally be reached on Monday through Thursday, 8:00 AM - 5:30 PM.

a. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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b. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Barbara Gilliam

Barbara Gilliam
Examiner
Art Unit 1752

bg
June 14, 2004